

No. 15132

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

MUENCH-KREUZER CANDLE CO., INC., a corporation,
Appellant,

vs.

LESTER F. WILSON,
Appellee.

APPELLANT'S REPLY BRIEF.

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In its Opening Brief, appellant made three points:

(1) Non-infringement since September 5, 1952, because defendant's candles do not have dye "normally undissolved in the wax of said body" (Patent Claim 1);

(2) Invalidity of Claims 1-6 of the patent in suit as embodying no invention but constituting a mere duplication or multiplication of colors of the single core or wick of the prior Star-Pillar, Housamann (German) or Sterry (British) candles; and

(3) Invalidity of the patent in suit as having been procured by a false representation to the Board of Appeals of the Patent Office "that the metallic salts * * * in the references * * * could not color the drippings even if the candles were of the drip producing type."

None of these arguments has been met by appellee.

Appellee's brief is devoted in the main to quoting the findings of the District Court, on which, of course, he so heavily relies.

But key findings upon which this entire position of appellee must fall are obviously "clearly erroneous."

Finding 13 Is Clearly Erroneous.

Appellee seeks to avoid the effect of the prior art by falsely asserting that none of the prior art relates to a "drip" candle.

Thus appellee has procured from the District Court a finding:

"13. None of the prior patents or *publications* relied upon by defendant refers to a drip candle, or reveals any contemplation of making a candle which characteristically is of a wax dripping type."

This finding is made despite the fact that defendant's catalogues, as published annually from 1940, have advertised its Star-Pillar candle, Exhibit F, as a candle which "*drips red over a white exterior.*" See Defendant's Exhibit C.

It is noted that Exhibit C bears a certificate which proves its publication, a certificate that it was received in the Patent Office Library January 14, 1943.

In view of this incontrovertible evidence, appellant is amazed that appellee should present to the District Court and here rely on Finding 13.

The existence of this publication in the prior art does, however, account for the fancy footwork on page 34 of appellee's brief where, in discussing Specification of Error XIII, which by coincidence challenges Finding 13, appellee makes a quick switch from "patents or *publi-*

cations,” as set forth in the finding, to simply “prior patents.”

Moreover, all candles drip. Numerous candles were produced at the trial having 9, 21 and 30-ply wicks. Exhibit G-2 has a 30-ply wick [R. 189], E-3 a 21-ply wick [R. 233] and H-1 a 21-ply wick [R. 234].

They all dripped, as remarked by the trial court [R. 242], and as this Court can see by inspecting the exhibits, and “If those candles had a 45-ply wick in them, they would drip.” [R. 243]. Plaintiff Wilson admitted this, “There aren’t any candles made that in the draft won’t drip.” [R. 297].

Consequently, we reaffirm our position that the patent in suit is a mere multiplication using two or more colors instead of the one color of the prior Star-Pillar candle, Housamann (German) candle or Sterry (British) candle and hence void for want of invention.

The Patent in Suit Was Procured by a Fraud on the Patent Office.

Appellee has devoted a large portion of its brief to a discussion of the testimony, especially on cross-examination, of defendant’s witness, Muench, particularly with respect to the evidence offered to show that certain metallic salts referred to in the Nelson and Fredericks prior art patents, when applied to the wicks of candles as proposed by the patentees would color the drippings of those candles.

The purpose of this evidence was to show that certain of the metallic salts would color the drippings and that Wilson’s flat assertion to the Board of Appeals that “they could not affect the color of drippings, even if the candles were of the drip producing type” was false.

Let us assume the worst. Let us assume that appellee has completely destroyed the evidence of Mr. Muench and that defendant has not thereby proved that such metallic salts will color the drippings.

Still, the plaintiff has proved it for us. Plaintiff's expert witness, Bechtold, testified:

"The Court: But if you used more than that, they would color the drippings?"

The Witness: Yes.

The Court: And you could get green and red—and what is the other?

Mr. Lyon: Blue.

The Court: Blue?

The Witness: Drippings, yes." [R. 288].

And plaintiff has stipulated "that it was known in the candle-making art * * * that metallic salts * * * were useful in the coloring of candles, * * *" [Deft. Ex. B; R. 393].

Clearly, the flat assertion made to the Patent Office Board of Appeals was made with intent that the Board rely upon it, as they did, and order the granting of the patent which, up to that time, had been denied. This assertion of fact was made despite the fact that plaintiff made no inquiry as to whether it was true and did not in fact know whether it was.

Thus, all of the elements of fraud appear here. Certainly, if a "reckless misrepresentation" is enough to revoke a man's United States citizenship, *Schwinn v. United States*, 112 F. 2d 74 (9 Cir.), it is enough to revoke his patent.

Non-infringement Since September 5, 1952.

In our Opening Brief, we pointed out that both in the plain meaning of Claim 1 and by reason of a file wrapper estoppel, defendant's candles, which are made by painting wax containing dye dissolved therein on a taper prior to finishing the candle, cannot be infringements of Claim 1, being limited as it is to a candle in which the dyes are "normally undissolved in the wax of said body."

There are, of course, only two parts to a candle, the wick and the body. Plaintiff has a patent on a candle in which dye is applied to the wick *and not to the body*. Defendant applies dye to the body *and not to the wick*. A clearer case of non-infringement is hard to imagine.

Appellee's only answer to this argument is that we cannot escape infringement by moving the dye $\frac{1}{8}$ inch (Appellee's Br. p. 31). But here, appellee misconceives the law of file wrapper estoppel. By amending application Claim 18 to include the phrase "normally undissolved," the patentee effectively excluded "dissolved," and it matters not that the point at which the dye is initially dissolved is a mere $\frac{1}{8}$ inch from the wick. It does matter that the accused candles contain dye dissolved in the candle body whereas Claim 1 was deliberately amended to be "Normally undissolved in the wax of the body."

Indeed, in the case relied upon in our Opening Brief, *D. H. Electric Co. v. M. Stephens Mfg., Inc.*, 233 F. 2d 879 (9 Cir.), a difference of 1° - 5° from perpendicular was enough to distinguish and render non-infringed claims limited to "substantially perpendicular."

We have pointed out in our Opening Brief that the District Court's interpretation of the phrase "normally

undissolved in the wax of said body” would make the claim co-extensive with Claim 18 of the application prior to the amendment and that the District Court, in effect, ignored the amendment.

As pointed out in the case just cited, this the court was not at liberty to do, and conclusion of law 3, reading as follows:

“3. Examination of the file history of the Wilson patent application reveals no estoppel against plaintiff’s assertion of validity and infringement.”

is clearly erroneous.

We ask this simple question of appellee: What did the referred to amendment of Claim 18 add to Claim 18? Or, how can “dissolved” become “undissolved?”

Clearly, the Court erred in concluding that defendant’s candles, as manufactured since September 5, 1952, infringed Claim 1 of the patent in suit.

In summary, we believe that we have demonstrated that under applicable rules of law, plaintiff’s patent is invalid on two grounds and has not been infringed by defendant in its production since September 5, 1952.

Respectfully submitted,

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